



Paper 16

FISH & RICHARDSON, PC  
4350 LA JOLLA VILLAGE DRIVE  
SUITE 500  
SAN DIEGO CA 92122

COPY MAILED

AUG 26 2002

OFFICE OF PETITIONS

In re Application of  
Simon, et al.  
Application No. 09/496,135  
Filed: 5 May, 1999  
Attorney Docket No. 06618/363002/CIT 2885-P2

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §1.47(b),<sup>1</sup> filed 15 June, 2000, but not received into the Office of Petitions until this writing.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

Any petition (and fee) for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventors.

Failure to respond will result in abandonment of the application.

### BACKGROUND

The record indicates:

- this application was filed on 1 February, 2000, without an executed oath or declaration by the two named inventors Marvin K. Simon (Mr. Simon) and Tsun-Yee Yan (Mr. Yan);
- accordingly, a Notice of Missing Parts was mailed on 9 March, 2000;
- in response to the Notice of Missing Parts, Petitioner filed on 15 June, 2000, *inter alia*, a request and fee for a four- (4-) month extension of time, the surcharge and the instant petition;
- the petition is supported by no documentation evidencing mailing of the entire application to Mr. Simon and Mr. Yan, and the statement by Counsel:

<sup>1</sup> The regulations at 37 C.F.R. §1.47, in pertinent part:

§1.47 Correction of inventorship in a patent application, other than a reissue application.

\*\*\*

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the *Official Gazette*. An inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

--suggests that the entire application was not mailed to Mr. Simon and Mr. Yan at their respective residences for their review and signature; and

--fails to set forth the last known residential address of all of the inventors as required.

- thus, the petition and attachments failed to provide:

--any indication that the materials had been sent individually to each inventor at his/her last known place of residence;<sup>2</sup> and

--complete statement (including postal code) of the last known address of the inventor(s) in question.

### ANALYSIS

Petitioner has failed to establish its proprietary interest and that the inventors cannot be found to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events) or cannot be reached.

A copy of the application papers must be sent to the last known address of the non-signing inventor(s) with a request that he/she sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor(s) cannot be reached.

The submission must contain documentation evidencing that the entire application and the oath or declaration were sent to the inventors at his/her last know address. Such evidence should included a copy of the transmittal letter and a copy of the shipping waybill and the shipper's indication of delivery, refusal, or other non-delivery conditions.

An oath or declaration for the patent application in compliance with 37 C.F.R. §1.63 and §1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. (An oath or declaration in compliance with 37 C.F.R. §1.63 and §1.64 signed by the Rule §1.47 applicant is required.)

Moreover, Petitioner's Counsel must set forth in his/her statement their attestation that he/she believes all of the information submitted to be correct--including the required foregoing items and the statement of the last known addresses of the inventors.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks  
Box DAC  
Washington, D.C. 20231

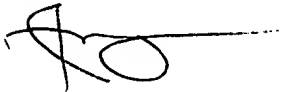
---

<sup>2</sup> A simple resolution to this problem is to attach to the renewed petition copies of the transmittal letters, along with (for example) a copy of the US Postal Service Express Mail documentation evidencing delivery or attempted delivery. The response of or failure to respond by the non-signing inventors to this effort clearly would satisfy Petitioner's showing requirement.

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy